

REMARKS

Claims 1-59 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 101 Rejection:

The Examiner rejected claims 1-59 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse this rejection for at least the following reasons.

According to the most recent Office Guidelines on patentable subject matter, the “useful, concrete and tangible result” analysis **only applies if the Examiner has first established a *prima facie* case that the claimed invention claimed invention covers a law of nature, natural phenomenon or abstract idea.** See Guidelines IV.C.1. Since the Examiner has never explained how the invention of claim 1 covers a law of nature, natural phenomenon or abstract idea, **the Examiner has failed to state a proper rejection.** Applicants claims are clearly not directed to a law of nature, natural phenomenon or abstract idea. For example, claim 1 is specific to a computer-implemented source resource containing a set of information objects that defines a set of users. Claim 1 also requires using the source resource definition for each source resource to discover the set of users from the source resource. Claim 1 also requires defining an additional resource containing a second set of information objects that corresponds to a user from the set of users, and using the additional resource definition to discover the second set of information objects from the additional resource. Moreover, claim 1 requires generating an association of each information object from the second set of information objects with the corresponding user from the set of users and with the additional resource. Clearly, claim 1 does not cover a law of nature, natural phenomena or abstract idea. There is nothing abstract about the method of claim 1. Instead, claim 1 is clearly directed to a very practical application. As stated in the Guidelines at IV.C.2.b: “The claim must be examined to see if it includes anything more than a § 101 judicial

exception [e.g., abstract idea]. If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world ... then the claim meets the statutory requirement of 35 U.S.C. § 101.” (emphasis added). Since the Examiner has never explained how the invention of claim 1 covers a law of nature, natural phenomenon or abstract idea, **the Examiner has failed to state a proper rejection.**

Furthermore, the invention as recited in claim 1 clearly provides a useful, concrete and tangible result. Claim 1 recites generating an association of each information object from a second set of information objects with the corresponding user from a set of users and with an additional resource. The Examiner states that the claimed invention is silent about any tangible result that comes after the generating. However, the generated association is a useful, concrete and tangible result. According to the Guidelines, “The tangible requirement does **not** necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing.” (emphasis added). Moreover, the association generated by a computer program process would inherently constitute tangible data within a computer.

Applicants refer the Examiner to *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) where the court stated that the relevant claim was statutory because “the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application ... because it produces ‘a useful, concrete and tangible result’ – a final share price”. Just like the implicitly produced final share price in *State Street* was considered a useful, concrete and tangible result and thus statutory, the explicitly generated association of each information object from a second set of information objects with the corresponding user from a set of users and with an additional resource, as recited in claim 1, is clearly a useful, concrete and tangible result and is thus statutory. Note that the final share price was not even explicitly recited in the claim in *State Street*. Moreover, as discussed by the court in *State*

Street, the final share price was tangible as data in a computer system. The same analysis as in *State Street* applies to the generated association of claim 1.

Even more on point, Applicants also refer the Examiner to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999). The claim in the *AT&T* case recites “**generating** a message record” and was held to be statutory. There is no difference between the generated message record in *AT&T* and the generated association of claim 1 in regard to statutory subject matter.

Similar arguments apply to the other independent claims.

CONCLUSION

Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-96801/RCK.

Also enclosed herewith are the following items:

- ☐ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,

/Robert C. Kowert/

Robert C. Kowert, Reg. #39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

Date: November 22, 2006